

REMARKS

I. INTRODUCTION

Claims 10 and 17-20 have been amended. Claims 2-20 are pending in the present application. No new matter has been added. In view of the following remarks, it is respectfully submitted that all of the presently pending claims are allowable.

II. THE 35 U.S.C. §112 REJECTIONS SHOULD BE WITHDRAWN

Claims 2-20 have been rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. (*See* Office Action of June 28, 2005, page 2).

The Examiner asserts that the specification and drawings, as originally filed and with the exception of originally submitted claims 10-15, do not include any mention of the use of software or a computer. (*See* Office Action of June 28, 2005, page 3). Therefore, the Examiner contends that recently amended claims 2-9, which recite steps performed by software, are not supported by the Applicants' disclosure. (*See id.*).

Contrary to the Examiner's assertions, the specification originally filed by the Applicants does in fact discuss using a computer. Specifically, the Applicants state that portions of the risk/opportunity management process may be automated. (*See* Specification, page 16, line 18). Automation may be facilitated by a risk/opportunity analysis generator (ROA generator), "which may be a computer based tool designed to compile and analyze risk and opportunity related input." (*See* Specification, page 16, lines 21-23).

In addition, the Applicants direct the Examiner's attention to originally filed claim 15 which clearly recites and supports "a computer-readable storage medium storing a set of

instructions, the set of instructions capable of being executed by a processor to project a future condition of a business entity.” This is part of the original disclosure, and fully supports that the remaining steps of claims 2-9 also be performed in the same manner.

The Examiner further asserts that inadequate support is provided for claim 2 which recites that a “monetary value is determined by a multiplication.” However, the Examiner fails to recognize the detailed discussion in the originally filed specification regarding “a computer-based storage medium... wherein the monetary value is determined by a multiplication.” For example, in step 410 of the method of Fig. 8, the Applicants disclosed that a ROA generator may multiply earnings before interest and taxes (“EBIT”) by a potential frequency to determine an expectancy value of the risk/opportunity. (See Specification, page 17, lines 8-9). The EBIT is inherently a monetary value, as earnings, interest, and taxes are always paid in money. When multiplied by any number, which may represent a potential or a frequency, the value would still be monetary.

The Examiner further contends that claim 4, which recites “a computer-readable storage medium... wherein the set of instructions performs the steps of handling at least one of the risks” and “handling at least one of the opportunities,” is not supported by the originally filed disclosure. However, this limitation is also discussed with respect to at least the method of Fig. 8. Specifically, in step 450, the ROA generator “may apply the risk/opportunity handling measure... and recalculate the expectancy value of the risk/opportunity based on the risk/opportunity handling measure.” (Specification, page 18, lines 7-10). The Applicants further provide an example wherein a \$1M risk is handled by purchasing insurance with a \$50,000 deductible, and thus the expectancy value is recalculated by the ROA generator to be \$50,000 (a monetary value) times the potential frequency. (See Specification, page 18, lines 10-20).

In light of the above specified disclosures supporting the limitations of claim 2-9, it is respectfully submitted that these claims are allowable and the 35 U.S.C. §112, first paragraph rejections should be withdrawn.

The Examiner rejected claims 10-14, asserting that the various "means" recited are not adequately described in the specification. (*See* Office Action of June 28, 2005, page 4). Specifically, the Examiner claims that "the specification does not clarify which structure, if any, is associated with the recited means." (*Id.*).

The Examiner fails to recognize that the originally filed disclosure describes at least one structure which may be associated with the various means of claim 10. Specifically, as mentioned above, the originally filed disclosure of the present invention discusses an implementation of a ROA generator. The ROA generator may receive and store data corresponding to a plurality of risks/opportunities (step 400), receive data corresponding to one of a probability and a frequency that the risk/opportunity will occur (step 400), and project the future condition of the business entity (step 410, step 450). Thus, it is respectfully submitted that the Examiner's rejection of claims 10-14 under 35 U.S.C. §112, first paragraph, should be withdrawn.

The Examiner expresses confusion with regard to independent claims 10, 15, and 17, all of which recite similar limitations. Claim 15, for example, recites the steps of "determining... for each of the risks, one of a probability that the risk will occur during a predetermined period of time and a frequency at which the risk will occur; determining... for each of the opportunities, one of a probability that the opportunity will occur during a predetermined period of time and a frequency at which the opportunity will occur" and "projecting... the future condition of the business entity based on a monetary value of each of the risks and opportunities, wherein the monetary value for each of the risks and opportunities is determined based on the potential monetary impact and the corresponding one of frequency and probability." The Examiner questions what analysis could be generated in a scenario where "the risk is based on a probability that the risk will occur during a predetermined period of time and the opportunity is based on a frequency at which the opportunity will occur." (Office Action of June 28, 2005, page 4).

The Examiner fails to recognize that the future condition of the business entity is projected "based on a *monetary value of each of the risks and opportunities*." That is, what is analyzed is the monetary values corresponding to the risks/opportunities and the probability/frequency of their occurrence. Thus, there is no "apples-and-oranges" comparison between probability versus frequency, as the Examiner contends. Therefore, it is respectfully submitted that claims 10, 15, and 17 are allowable under 35 U.S.C. §112, first paragraph, and that the rejections of these claims should be withdrawn.

Claims 2-20 have also been rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to point out and distinctly claim the subject matter which the Applicants regard as the invention. (See Office Action of June 28, 2005, page 5).

In light of the above described rejection of claims 10-14 under 35 U.S.C. §112, first paragraph, the Examiner asserts that the scope of the recited means is ambiguous, and thus these claims are indefinite. As discussed above, the originally filed disclosure describes at least one structure (i.e., the ROA generator) which may be associated with the claimed means. Therefore, it is respectfully submitted that the rejection of these claims under 35 U.S.C. §112, second paragraph, should be withdrawn.

The Examiner rejected claims 10, 15, and 17, and the claims depending therefrom, based on the same argument discussed above with respect to the rejection under 35 U.S.C. §112, first paragraph. Therefore, for at least the reasons discussed above, it is respectfully submitted that the rejection of these claims under 35 U.S.C. §112, second paragraph, should be withdrawn.

III. THE 35 U.S.C. §101 REJECTIONS SHOULD BE WITHDRAWN

Claims 10-14 and 17-20 have been rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. (See Office Action of June 28, 2005, page 7).

The Examiner rejected claims 10-14 on the basis that a structure corresponding to the claims means was not disclosed, and thus the recited means are interpreted as software *per se*, which is deemed to be non-statutory. (*See id.*). However, in light of the discussion above highlighting the original disclosure of at least the ROA generator, it is respectfully submitted that claims 10-14 are allowable.

The Examiner rejected claims 17-20 as failing to apply, use, or advance the technological arts. Claims 17-20 have been amended to comply with the requirements of 35 U.S.C. §101. Therefore it is respectfully submitted that the rejection of these claims should be withdrawn.

CONCLUSION

In light of the foregoing, Applicants respectfully submit that all of the pending claims are in condition for allowance. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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